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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/690,409
Filing Date: October 17, 2000
Appellant(s): WILD ET AL.

Steven B. Pokotilow
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 15, 2009 appealing from the Office action mailed July 15, 2008.

The appeal brief is filed in the new format under the revised BPAI final rule before the effective date of the BPAI final rule. The Office published the BPAI final rule to amend the rules governing practice before the BPAI in *ex parte* patent appeals. See *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Final Rule*, 73 FR 32938 (June 10, 2008), 1332 Off. Gaz. Pat. Office 47 (July 1, 2008). However, the effective date for the BPAI final rule has been delayed. See *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates*, 73 FR 74972 (December 10, 2008). In the notice published on November 20, 2008, the Office indicated that the Office will not hold an appeal brief as non-compliant solely for following the new format even though it is filed before the effective date. See *Clarification of the Effective Date Provision in the Final Rule for Ex Parte Appeals*, 73 FR 70282 (November 20, 2008). Since the appeal brief is otherwise acceptable, the Office has accepted the appeal brief filed by appellant.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The statement of the related appeals cases contained in the brief is correct.

There was a prior appeal decision affirming the examiner in this application.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. As set forth in the final rejection, claims 7-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 7, 9, 10, 12, 15 and 17 of U.S. Patent No. 6,681,547 in view of Geyssel (4,584,046).

(7) Claims Appendix

The statement of the status of claims contained in the brief is correct.

(8) Evidence Relied Upon

4,572,758	Wild	2-1986
4,584,046	Geyssel	4-1986
6,681,547	Wild et al.	1-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. Claims 7-10 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 7, 9, 10, 12, 15 and 17 of U.S. Patent No. 6,681,547 in view of Geyssel (4,584,046). Although the conflicting claims are not identical, they are not patentably distinct from each other, and the additional limitations that are added to the claims in the present application can be rejected in view of the Geyssel reference (4,584,046). In this instance case, Geyssel discloses and suggests, among other things, the method steps of: providing a plurality of straws above the conveyor belt, providing straws at an acute angle the conveyor belt or providing straws substantially parallel to a side wall of the bag.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the U.S. Patent No. 6,681,547 by incorporating the method as taught by Geyssel to provide a more effective method of applying drinking straws onto the stand up bag.

Claim Rejections - 35 USC § 103

2. Claim 7, 9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geyssel (4,584,046) in view of Wild (4,572,758).

Geyssel discloses (figures 1-10) an apparatus and a method comprising:

providing a plurality of standup bag 12;

positioning a bag on a conveyor belt (13) so that the second side wall is at an acute angle with the conveyor belt (figure 9);

applying a straw package (11) onto the second side wall an acute angle to the conveyor belt (figure 9).

providing a plurality of straw packages from above the conveyor belt (Fig. 1 of Geyssel clearly shows that the straw packages are located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

providing a transfer drum (20) above the conveyor belt, the transfer drum being rotatable about an axis substantially parallel to the second side wall (Fig. 1 of Geyssel clearly shows that the transfer drum is located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

providing a lever having a depressing arm (41a) and a pivoting arm (49);

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply a straw package onto the second side wall at an acute angle to the conveyor belt (figures 1 and 6 of Geyssel – column 4, lines 62-68 and column 5, lines 1-14);

Geyssel discloses, column 1, lines 43-47, that:

"It is the task of this invention to create a system with which objects, in particular drinking straws, labels, or the like, can be attached to objects such as packages, bottles, bags, etc., these being moved past on a conveyor belt..." (emphasis added),

and on column 1, lines 6-8, that:

"This invention relates to a device for attaching articles such as labels, drinking straws or the like to packages, bottles or other objects" (emphasis added),

and in the Abstract:

"The applicator device (10) can be tilted about two perpendicular directions and can be secured in order that the drinking straws (11) can be secured in different directions and on variously inclined surfaces of the package (12)" (emphasis added),

and on column 2, lines 19-31, that:

"It is expedient that the applicator element can be tipped in several directions in order that the article that has been made ready can be applied in various positions and on variously configured objects as selected ... the applicator element and the drive system are installed together on a carrier that can be tilted about two perpendicular axes and which can be secured ... the applicator element can be placed in any desired angular position against the objects to which the articles are to be secured" (emphasis added).

It is further construed that Geysel clearly teaches and suggests the apparatus and method steps in which: the bag (12) includes the bag as recited in the Applicant's present claimed invention, and the drinking straws can be applied to the bag (of any design configuration – shapes and material) at any desired angular position with respect to the conveyor surface.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geysel apparatus and method to provide the foil bag (well known in the art) as recited in the claimed invention.

As discussed above, Geyssel discloses the claimed invention, but it does not expressly disclose the straw packages having an adhesive thereon and a cover strip covering the adhesive.

Wild discloses an apparatus and a method comprising: the straw packages having an adhesive thereon and a cover strip covering the adhesive (column 2, lines 22-29) in which the adhesive strip (29) is applied on the straw package (12) prior to the step of applying the straw package onto the second side wall of the container (bag). Wild provides *"a process and apparatus for increasing the yield of straws affixed to beverage containers by providing an adhesive on the straw packages"* (Wild – column 2, lines 46-49).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and method by incorporating the apparatus and method as taught by Wild to provide a more effective machine and method of attaching drinking straws onto containers.

Geyssel modified by Wild further discloses the method and apparatus that includes the steps of removing the cover strip from the plurality of straw packages and exposing the adhesive as recited (column 2, lines 22-29).

(10) Response to Argument

Appellant's arguments filed in the brief have been fully considered but they are not persuasive. It is noted that appellant has not identified any error made by the

examiner in applying the obviousness type double patenting rejection. Therefore, the Board is urged to uphold this rejection.

1. In response to the Appellant's argument that:

"The Scope Of The Prior Art And Differences Between The Prior Art And The Claimed Invention.

Neither Geyssel nor Wild render the claimed invention obvious because there are substantial differences between both references and the claimed methods and systems for affixing straw packages to containers. Most significantly, neither Geyssel nor Wild, either alone or in combination, teach or suggest each and every element of the claimed invention. Also, neither Geyssel nor Wild solve the problem addressed by the claimed invention",

this is not found persuasive for the following reason: the examiner maintains that Geyssel modified by Wild, as discussed above, discloses the claimed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Finally, according to the MPEP 2111 [R-1] - Claim Interpretation; Broadest Reasonable Interpretation:

*"During patent examination, the pending claims must be "given *their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)".*

2. In response to the Appellant's argument that:

Geyssel is directed to affixing straw packages onto box type packages, which are inherently made of robust materials in order to have sufficient

structural integrity to maintain their shape (See, e.g., Geyssel Fig. 1), standing in an **upright position** (See, e.g., col 5, row 45; col 6, row 50; Fig. 10), and wherein the **adhesive is placed on the package**, rather than the straw package, prior to application of the straw package (col 5, row 29). The member used to affix straw packages, as explained in Geyssel, is a two-arm tilt lever that pivots about the joining portion of the two arms as a result of a spring urging the two-arm tilt lever to pivot. (col 4, row 63). In another embodiment, Geyssel is directed to a lever that is moved toward and away from the containers in a **lateral movement** (col 2, row 34)",

this is not found persuasive for the following reasons:

Geyssel discloses, column 1, lines 43-47, that:

"It is the task of this invention to create a system with which objects, in particular drinking straws, labels, or the like, can be attached to objects such as packages, bottles, bags, etc., these being moved past on a conveyor belt..." (emphasis added),

and on column 1, lines 6-8, that:

"This invention relates to a device for attaching articles such as labels, drinking straws or the like to packages, bottles or other objects" (emphasis added),

and in the Abstract:

"The applicator device (10) can be tilted about two perpendicular directions and can be secured in order that the drinking straws (11) can be secured in different directions and on variously inclined surfaces of the package (12)" (emphasis added),

and on column 2, lines 19-31, that:

"It is expedient that the applicator element can be tipped in several directions in order that the article that has been made ready can be applied in various positions and on variously configured objects as selected ... the applicator element and the drive system are installed together on a carrier that can be tilted about two perpendicular axes and which can be secured ... the applicator element can be placed in any desired angular position against the objects to which the articles are to be secured" (emphasis added).

Again, Geyssel clearly teaches and suggests that the apparatus and method discloses by Geyssel can accommodate the containers of any material and shapes (*packages, bottles, bags, etc., & packages, bottles or other objects*) and those containers can be placed on the conveyor **in any desired angular position** – in other words, the container can be placed on the conveyor from an upright position all the way down to laying with one side flat on the conveyor.

Accordingly, the straw applicator is designed to be tipped in any desired angular position as well to accommodate the various containers (of any kind of material and shapes) which can be positioned on the conveyor **in any desired angular position** – in other words, the depressing arm of Gysel (apparatus and method) is fully capable of being displaced downward toward the conveyor belt as recited.

Finally, regarding the issue of the straw packages having adhesive thereon and a cover strip covering the adhesive, Wild is relied upon for the teaching of the straw packages having an adhesive thereon and a cover strip covering the adhesive (column 2, lines 22-29) and the adhesive strip is applied on the straw package prior to the step of applying the straw package onto the second side wall of the container (bag).

3. In response to the Appellant's argument that:

"No Prima Facie Case Of Obviousness Can Be Established Because There Is No Reason One Of Ordinary Skill In The Art Would Combine Geyssel And Wild To Achieve The Claimed Invention";

"It would not be obvious to one of ordinary skill in the art to combine Geyssel and Wild because substantial modifications of the Geyssel and Wild would be necessary to achieve the claimed invention";

"One of ordinary skill in the art would not combine Geyssel and Wild because neither reference solves the problem remedied by the claimed invention";

"Geyssel In View Of Wild Does Not Render The Claimed Invention Obvious Because No Combination Of Geyssel And Wild Teach Or Suggest Affixing Straw Packages Having An Adhesive Thereon To A Foil Bag Using The Method And Apparatus As Claimed"; and

"Neither Geyssel nor Wild, or any combination thereof, teach or suggest positioning a foil bag so that it lies on the conveyor belt on a side wall as claimed in claims 7, 9, 11-12 and 14",

these are not found persuasive for the following reasons:

The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, as discussed above, Geyssel clearly teaches and suggests that the apparatus (and method) of Geyssel is fully capable of accommodating containers formed by various material and in various shapes:

Geyssel discloses, column 1, lines 43-47, that:

"It is the task of this invention to create a system with which objects, in particular drinking straws, labels, or the like, can be attached to objects

such as packages, bottles, bags, etc., these being moved past on a conveyor belt..." (emphasis added),

and on column 1, lines 6-8, that:

"This invention relates to a device for attaching articles such as labels, drinking straws or the like to packages, bottles or other objects" (emphasis added),

and Geysel further discloses that:

"The applicator device (10) can be tilted about two perpendicular directions and can be secured in order that the drinking straws (11) can be secured in different directions and on variously inclined surfaces of the package (12)" (emphasis added) (Abstract),

and on column 2, lines 19-31, that:

"It is expedient that the applicator element can be tipped in several directions in order that the article that has been made ready can be applied in various positions and on variously configured objects as selected ... the applicator element and the drive system are installed together on a carrier that can be tilted about two perpendicular axes and which can be secured ... the applicator element can be placed in any desired angular position against the objects to which the articles are to be secured" (emphasis added).

Clearly, the straw applicator as taught by Geysel can be positioned in any desired angles to accommodate the containers (formed by various material and various shapes) positioned on the conveyor at any desired angular position (whether an upright position or laying flat on one side of the container), and thus the depressing arm of Geysel is fully capable of being displaced downward toward the conveyor belt as recited.

Wild is relied upon for the teaching of an apparatus and a method in which the straw packages having an adhesive thereon and a cover strip covering the adhesive (column 2, lines 22-29), and the adhesive strip (29) is applied on the straw package (12)

prior to the step of applying the straw package onto the second side wall of the container (bag). Wild provides ***“a process and apparatus for increasing the yield of straws affixed to beverage containers by providing an adhesive on the straw packages”*** (Wild – column 2, lines 46-49).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and method by incorporating the straw packages having adhesive thereon as taught by Wild to provide a more effective machine and method of attaching drinking straws onto containers.

Furthermore, it would have been obvious to combine the references, since it has been held that applying a known technique to a known device would have yield predictable results to one of ordinary skill in the art at the time of the invention (KSR).

4. In response to the Appellant's argument that:

“On the contrary, neither Geyssel nor Wild are directed to means of affixing straw packages onto containers, whereby the containers lie on a side wall on a conveyor belt at the time the straw packages are affixed thereto. For example, figure 10 of Geyssel depicts a push rod 68 in the vertical position contacting a drinking straw 11 to a vertical side of the package 12. Additionally, while Geyssel discusses the topic of angles, Geyssel is directed to changing the angle of the straw applicator to affix straw packages to packages of varying diagonal directions. Geyssel does not teach or suggest a depressing arm structured for affixing straw packages with an adhesive on the straw package to a flexible foil bag on a conveyor belt as claimed in claim 13”,

this is not found persuasive for the following reasons:

As shown in Fig. 6 of Geyssel, the depressing arm (41a) and a pivoting arm (49) (as one depressing arm assembly) are working in concert with the straw applicator (the transfer drum 20), accordingly, as the straw applicator tilted in various angular position so is the depressing arm. It should be pointed out that Fig. 10 of Geyssel is the other embodiment of the depressing arm (of the same invention), which is not relied upon for the rejection.

(11) Related Proceeding(s) Appendix

A copy of the Board decision identified in the Related Appeals and Interferences section is contained in the brief.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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